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EXAMINER

DEBELIE, MITIKU W

ART UNIT	PAPER NUMBER
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2621

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07/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/759,425

Applicant(s)

SEO ET AL

Examiner

Mitiku Debelie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/30/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Korea on 02/14/2003. It is noted, however, that applicant has not filed a certified copy of the 10-2003-009486 application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

2. The reference listed in the information disclosure statement filed on 11/30/2004 has been considered by the examiner.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1 – 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 22 of copending Application No. 10/759460. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions relate to managing reproduction of still images and related data associated with the still pictures with the related data being graphic data and subtitle data. Both inventions also relate to multiplexing the still image and the related associated data into transport stream and packetized elementary streams.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1 - 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 1 defines a recording medium having a data structure for managing reproduction of still images. The claimed invention would have been statutory had it been worded to include computer program embedded in a computer readable medium. Computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationship between the computer program and the rest of the computer which permit the computer

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program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 11, 12 and 15 - 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Hamada et al (U.S. Patent Number 6,999,674).

As to claim 1, Hamada discloses a recording medium having a data structure for managing reproduction of still pictures (audio and video data), comprising (see col. 2, lines 25-42, col. 6, lines 46 – 53):

a playlist area storing at least one playitem and at least one playlist, the playlist including at sub-playitem (clip) (see Fig. 2, col. 6, lines 17 – 18 and 35), the playitem providing navigation information for reproducing at least one still picture (audio and video data) from a first file, the sub-playitem providing navigation information for reproducing audio data from a second file (see col. 6, lines 11 – 18).

As to claim 2, Hamada teaches a recording medium comprising: a data area storing the first and second files (col. 18, lines 19 – 30).

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As to claim 11, Hamada teaches a recording medium comprising a data area storing the first File, and the first file does not include audio data (see col. 13, lines 15 – 26).

As to claim 12, claim 12 cites **“A recording medium having a data structure for managing reproduction of still picture, comprising;**

a playlist area storing at least one playlist file, the playlist file including at least one playitem and at least one sub-playitem, the playitem providing navigation information for reproducing at least one still picture from a first data stream, the sub-playitem providing navigation information for reproducing an audio stream from a second data stream separate from the first data stream” This claim reads on claim 1 above.

As to claim 15, claim 15 cites, **“A method of recording a data structure for managing reproduction of at least one still image on a recording medium, comprising:**

recording at least one playlist on the recording medium, the playlist including at least one playitem and at least one sub-playitem, the playitem providing navigation information for reproducing at least one still picture from a first file, the sub-playitem providing navigation information for reproducing audio data from a second file.” This claim reads on claim 1 above.

As to claim 16, claim 16 cites, **“A method of reproducing a data structure for managing reproduction of a least one still image recorded on a recording medium, comprising:**

reproducing at least one playlist from the recording medium, the playlist including at least one playitem and at least one sub-playitem, the playitem providing navigation information for reproducing at least one still picture from a first file, the sub-playitem providing navigation information for reproducing audio data from a second file.” This claim reads on claim 1 above.

As to claim 17, Hamada discloses an apparatus for recording a data structure for managing reproduction of at least one still image on a recording medium (see col. 2, lines 25 42, col. 6, lines 46 – 53), comprising:

a driver (optical head 2) for driving an optical recording device to record data on the recording medium (see Fig. 1, col. 5, lines 7 – 9);

a controller (CPU 21) for controlling the driver to record at least one playlist on the recording medium, the playlist including at least one playitem and at least one sub-playitem, the playitem providing navigation information for reproducing at least one still picture from a first File, the sub-playitem providing navigation information for reproducing audio data from a second file (see Fig. 1, col. 5, lines 53 – 54)

As to claim 18, claim 18 cites, “ **An apparatus for reproducing a data structure for managing reproduction of at least one still image recorded on a recording medium, comprising: a driver for driving an optical reproducing device to reproduce data recorded on the recording medium; a controller for controlling the driver to reproduce at least one playlist from the recording medium, the playlist including at least one playitem and at least one sub-playitem, the playitem providing navigation information for reproducing at least one still picture from a**

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first File, the sub-playitem providing navigation information for reproducing audio data from a second file.” This claim reads on claim 17 above.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamada et al (U.S. Patent Number 6,999,674) as applied to claims 1 and 2 above, and further in view of Sako et al. (U.S. Patent Number 6,829,211).

As to claim 3, all the limitations have been analyzed by Hamada in relation to claim 1 above except that the claim further includes reproducing related data associated with the still picture that is to be reproduced.

Sako et al. teaches a recording and reproduction of associated data with the still picture that is to be recorded or reproduced (e.g. graphic data, character data) (see col. 6, lines 11 – 18).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate associating related data with still picture in order to provide more supplemental description to the still picture visually presented to the user.

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As to claim 4, all the limitations have been analyzed in relation to claim 3 above.

As to claim 5, Sako teaches a recording medium wherein data associated with the recorded still picture is subtitle (character) data (see col. 6, lines 11 – 18).

As to claim 6, Hamada teaches a recording medium wherein the presentation data is divided into one or more still picture units such that each still picture unit includes at least one still picture and associated related data (see col. 6, lines 46 – 53). Hamada, however, does not teach data associated with the still picture. Sako et al. teaches a recording medium wherein data associated with the still picture are recorded (e.g. graphic data, character data) (see col. 6, lines 11 – 18).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate associating related data with still picture in order to provide more description to what is visually presented.

11. Claims 7 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamada et al (U.S. Patent Number 6,999,674) and Sako et al. (U.S. Patent Number 6,829,211) as applied to claims 3 - 6 above, and further in view of European Telecommunication Standard (ETS 300 743).

As to claim 7, note the discussion of Hamada above. Hamada does not teach a recording medium wherein the presentation data is multiplexed into a transport stream on a still picture unit by still picture unit basis.

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European Telecommunication Standard (hereafter ETSI) teaches audiovisual data multiplexed (converted) into a transport stream (see page 44 A.7).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate converting of the presentation data in to a transport stream in order to make it transportable.

As to claim 8, note the discussion of Hamada and ETSI above. Both Hamada and ETSI do not teach a recording medium wherein each elementary stream of the presentation data are aligned within the still picture unit.

ETSI teaches a recording medium wherein each elementary stream of the presentation data are aligned within the moving picture unit (MPEG-2) (see page 11, paragraph 3).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate aligning of a picture with the presentation unit as taught by ETSI in order to sequentially reproduce and store the recorded data.

As to claim 9, ETSI teaches a recording medium wherein each elementary stream is a packetized elementary stream (see page 11, paragraph 3).

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamada et al (U.S. Patent Number 6,999,674) as applied to claims 7 – 9 above, in view of Sako et al. (U.S. Patent Number 6,829,211) and European Telecommunication Standard (ETS 300 743) and further in view of Plourde, JR (U.S. Publication Number 2006/0195633).

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As to claim 10, note the discussion of Hamada and ETSI. The proposed combination of Hamada and ETSI does not disclose a recording medium wherein each still picture unit includes one packet from each packetized elementary stream. Plourde, JR teaches a recording medium wherein each still picture (audio and video data) unit includes one packet from each packetized elementary stream (see paragraph [0056]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention incorporate the inclusion of one packet from each packet represented in order to have the packets transported in sync with the image presented.

13. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamada et al (U.S. Patent Number 6,999,674) as applied to claim 12 above, and further in view of European Telecommunication Standard (ETS 300 743).

As to claim 13, Note the discussion of Hamada in claim 1 above. Hamada does not teach a recording medium wherein the first data stream is a transport stream. ETSI, from the same field of endeavor, teaches a data stream where the data stream is a transport stream (see page 11, paragraph 2).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the transport stream as taught by ETSI to the recording medium of Hamada in order to make the streams transportable.

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As to claim 14, ETSI teaches wherein the transport stream including packetized elementary streams of the moving picture and related data (see page 11, paragraph 3).

Therefore it would have been obvious to one of ordinary skill at the time of the invention to incorporate transport stream that includes packetized elementary streams of still picture and related data in order to be able to transport still picture and related data in packets that can be recognized at the receiving end.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hamada et al. (U.S. Pub. No. 2005/0105888), Kato et al. (U.S. Pub. No. 2005/0196143), Kato (U.S. Pub. No. 2005/0201718) and Hamada et al. (U.S. Pub. No. 2005/0254363) are cited to teach managing audio and video information on a recording medium.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitiku Debelie whose telephone number is (571) 270 1706. The examiner can normally be reached on Mon - Fri 8:00 - 5:00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on (571) 272 7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MD
07/18/2007

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for Thai Tran